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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,533	03/14/2001	Steve Pellegrin	07844-445001 / P409	3807
21876	7590	10/12/2004	EXAMINER	
FISH & RICHARDSON P.C. 3300 DAIN RAUSCHER PLAZA MINNEAPOLIS, MN 55402			FILIPCZYK, MARCIN R	
			ART UNIT	PAPER NUMBER

2161

DATE MAILED: 10/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/808,533

Applicant(s)

PELLEGRIN ET AL.

Examiner

Marc R Filipczyk

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 3, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-18 and 21 is/are rejected.
- 7) ☒ Claim(s) 7-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Response to Amendment***

This action is responsive to Applicant's RCE request and amendment filed June 28, 2004.

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 28, 2004 has been entered.

Claims 1, 2 and 4-18 are amended, claims 3, 19 and 20 have been cancelled and new claim 21 has been added, hence claims 1, 2, 4-18 and 21 are presented for examination.

***Claim Objections***

Claims 7 -10 are objected to because of the following informalities:

Regarding claim 7, the conversion service is capable of converting data, thus the phrase "is capable of" is redundant and must be deleted. The conversion feature should be written as: "wherein the conversion service converts..."

Regarding claim 10, the segment "a a single" contains an extra "a" character, thus "a" must be deleted.

Regarding claims 8-10 depend from objected claim 7, thus contain the deficiency of that claim and are objected to on the same merits.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 5, 6, 9, 10, 15 and 16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 5, 9 and 15 contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claimed feature that a conversion engine cooperates with an auxiliary conversion engine was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 6, 10 and 16 depend from rejected claims 5, 9 and 15 respectively, and therefore contain the deficiencies of those claims.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-10 and 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Regarding claims 5, 6, 9, 10, 15 and 16, the phrase “auxiliary conversion engine” is indefinite.

Regarding claim 7, the conversion service capable of converting an object from a first format to a second format is indefinite. It is not clear how the object and schemas are related.

Regarding claim 17, the claimed method steps must be written in an active form (i.e., identifying instead of “identify”).

Regarding claims 8-10 depend from claim 7 therefore contain the deficiencies of that claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 5, 7-9, 11-15, 17, 18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant Admitted Prior Art (AAPA) in view of Guck (U.S. Patent No. 5,911,776).

Regarding claims 1, 7, 11, 13, 17 and 18 AAPA discloses a method/program (page 1, lines 16, AAPA):

identify an object and a first format indicator associated with the object (page 1, line 16, AAPA);

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identify a second format indicator associated with a secondary program called by a primary program (page 1, lines 18 and 19, AAPA); and

apply a conversion engine, wherein the conversion engine takes input stream in a “source format” (data format), modify the data’s format and emit a data stream in the “target format” (current data format) (page 1, lines 26-28, AAPA) and reformat the object so it conforms to the current data format (page 1, lines 22 and 23, AAPA), but does not expressly teach that the conversion engine uses schemas to perform the conversion (reformatting).

However, Guck discloses an automatic format conversion system for multi user network (title, Guck) where schema on the server side (figure 1, items 10, 30, 50 and 54-56, Guck) is used to perform conversions by defining what functions will be supported and what converter objects and transformations can be handled by the manager and database (col. 18, lines 24-31, Guck).

Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the AAPA system in view of Guck by utilizing the schemas of an object taught by Guck in the AAPA system to convert data into the current (desired) data format type (fig. 4, block k, Guck). One of ordinary skill in the art would have been motivated to utilize schemas of an object for conversion so that applications used by the server and clients would use compatible formats for conversion on the server platform (fig. 4, Guck).

Regarding claims 2 and 12, AAPA/Guck disclose format indicators are format numbers (page 1, lines 16-18, AAPA).

Regarding claims 4, 5, 8, 9, 14 and 15, AAPA/Guck disclose a secondary program is a plug-in and the primary program is an application program associated with the plug-in (page 1, lines 24-28, AAPA).

Regarding claim 21, AAPA/Guck disclose the conversion service receives as inputs schemas contained in a plurality of different plug-ins (fig. 1, clients, Guck) and wherein the conversion service reformats objects associated with a plurality of different plug-ins (fig. 2A, Guck).

#### ***Response to Arguments***

Applicant's arguments filed on June 28, 2004 have been fully considered but they are not persuasive. The arguments and responses are listed below.

Applicant argues in the 6/28/04 response on page 7 regarding claim 7 that, "Guck fails to disclose or suggest a system wherein a conversion service is part of a primary program, such as a main application program, and schemas defining object formats are contained in one or more secondary programs, such as plug-ins".

In response to Applicant's argument, Examiner disagrees. Guck discloses a conversion system on the server side that is a main application and/or primary program (see fig. 1, Guck). Guck further discloses schema defining object formats (see fig. 1, items 54, 56 and 58). Guck's

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schema performs the same instructions as that claimed, and Applicant does not include any advantages or benefits for storing schema in the secondary program in any of the independent claims. Further, “plug-in” is not claimed in the argued claim 7. Last, AAPA in view of Guck teach the disclosed subject matter of claim 7 (see rejection).

Applicant argues in the 6/28/04 response on page 7 that, “As for the Applicants’ reference in their Background section to “conversion procedures [that] rely on format numbers appended to each block of persistent data,” is not an admission of prior art...”

In response to Applicant’s argument, Examiner disagrees. Note, “Background section.” Further, it is well known to ordinary skilled in the art of conversion engines that conversion procedures rely on format numbers appended to blocks of data in order to identify the version number and update the version if the current version is outdated. Last, Applicant’s have not submitted a “Terminal Disclaimer” to attempt to overcome the argued issue of background art.

With respect to all the pending claims 1, 2, 4, 5, 7-9, 11-15, 17, 18 and 21, Examiner respectfully traverses Applicant’s assertion based on the discussion cited above, as such, Examiner maintains the same rejection.

### ***Conclusion***

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most



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specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patent illustrates the state of art with respect to schema conversions:

U.S. Patent No. 6,430,556 of Goldberg et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R Filipczyk whose telephone number is 703-305-7156.

The examiner can normally be reached on Mon-Fri, 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MF  
October 4, 2004

  
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